

under 37 CFR 1.21(d) to amend the drawings, by adding a reference number to Figure 12, as indicated by the attached separate paper showing the proposed change in red. This proposed change, if approved, will overcome the Examiner's objection to Figure 12 in the drawings.

REMARKS

Reconsideration and allowance of this application is respectfully requested. Claims 1-77 are now in this application. Claim 15 has been amended to correct a clerical error.

Drawings:

In the February 28, 2002 Office Action the Examiner objected to Drawings for failing to comply with 37CFR 1.84(p)(5) because they do not include the following reference signs mentioned in the specification: the reference numerals 50 (per page 19, Line 18). . . Applicants respectfully traverse this objection and direct the Examiner's attention to the upper left portion of Figure 3 which includes reference number 50. To assist the Examiner in this task, applicants have included herewith a copy of Figure 3 with reference number 50 circled in red. Accordingly, Applicants respectfully request the objection to Figure 3 be withdrawn.

Claim Objections:

In the February 28, 2002 Office Action the Examiner objected to claim 15 because of the following informalities: Claim 15 should depend from claim 13 not from claim 12. Applicants have amended claim 15 to depend from claim 13 and accordingly request that the Examiner's objection be withdrawn.

35 U.S.C. 103(a):

In the February 28, 2002 Office Action the Examiner rejected all of the claims under 35 U.S.C. 103(a) as being "unpatentable over Greco et al U.S. Patent 5,568,540 in view of Koralewski et al U.S. Patent 5,875,239" or as being "unpatentable over Greco et al in view of

Koralewski et al. and further in view of Porter U.S. Patent 6,282,270.” Applicants respectfully traverse these rejections.

Claims 1, 34, 56 and 73 are the only independent claims. Accordingly, if these claims are novel over the cited art then the claims dependent therefrom are also novel. Accordingly, the following discussion will only reference these independent claims.

According to the Examiner, Greco et al. disclose every feature of these claims except “including a graphical image in the information signal.” However, the Examiner asserts that “[t]he Koralewski reference, a telephone call screening system, discloses a method of screening a telephone call by obtaining a caller identification information signal including a caller’s graphical image associated with the caller’s ID from a database (column 1, lines 59-67 to column 2, lines 1-4, and figure 4). . . Therefore, according to the Examiner, “it would have been obvious. . . to modify the Greco’s (*Sic.*) system with the teachings of Koralewski so that a registered user’s database in the Greco’s (*Sic.*) reference would have contained at least one graphical image in addition to his name and telephone number, and such data would have been included in an information signal sent to the called party for pending message notification, because such a modification would have enabled a called party identifying a source much quicker by just glancing at the graphical image, and retrieving the stored messages accordingly.” Applicants respectfully point out various errors with these assertions.

Improper to Combine References Since No teaching or Suggestion to Combine:

For an Examiner to assert that an invention is obvious over a combination of references, “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor, and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” In re Rouffet 149 F.3d

1350 (Fed. Cir. 1998). The Examiner has failed to show such reasons for this combination. Instead, the Examiner's reason for the combination of the two references is that it would be obvious to one skilled in the art to combine these references "because such a modification would have enabled a called party identifying a source much quicker by just glancing at the graphical image, and retrieving the stored messages accordingly." While this reason that the Examiner asserts discloses the results of the combination according to the Examiner, this reasoning does not explain why one skilled in the art confronted with the same problems as the inventor, and with no knowledge of the claimed invention would combine the teachings of a patent that describes a Method and Apparatus for Selecting and Playing a Voice Mail Message with a patent that describes a Telephone Call Screening System. The call screening system discloses and deals with issues that occur prior to a telephone call being connected and the voice mail system discloses and deals with issues that occur subsequent to the call being connected.

As the Federal Circuit has stated:

If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an [E]xaminer to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability." In re Rouffet 149 F.3d 1350, 1357 (Fed. Cir. 1998).

It follows that the only source of suggestion or incentive for the asserted modification of Greco et al. would be from hindsight derived from applicants' invention, which can not be relied upon as a source of a suggestion or motivation. As the Federal Circuit stated, using the claimed invention as a blueprint is illogical and inappropriate. Therefore the combination of Greco et al with Koralewski et al. asserted by the Examiner can not be considered obvious.

Since it is improper to combine these two references, and since neither reference alone would render these claims obvious the independent claims are novel over the cited art and should be allowed. Accordingly, Applicants respectfully request the rejections of all claims be withdrawn and the claims be allowed to issue.

Even If Combined the Cited References Do Not Teach or Suggest the Claimed Invention

According to the Examiner, Koralewski et al. “discloses a method of screening a telephone call by obtaining a caller identification information signal including a caller’s graphical image associated with the caller’s ID from a database (column 1, lines 59-67 to column 2, lines 1-4, and figure 4). . .” Applicants respectfully disagree with the Examiner’s interpretation of the Koralewski invention. According to the Koralewski specification, a caller identification apparatus is located at the called party location and is connected to the telephone lines. A computer is connected to an output of the caller ID apparatus. When the computer receives a caller ID signal from the caller ID apparatus, the computer uses the caller ID signal to access a local database, retrieve a graphical image, combine that image with a signal received from a signal source (i.e. a television tuner) and display the combined image on a connected television. (See Fig. 1, Col. 2, line 58 - Col. 3, line 12, and Col. 4, lines 26-43 and Col. 4, line 66 - Col. 5 line 39). Contrary to the assertion by the Examiner, the signal received by the system disclosed in the Koralewski patent does not include a graphical image or information related to a graphical image. Instead the signal received is a standard caller ID signal and the computer portion of the system is configured to associate that standard caller ID with a graphical image determined by the called party not by the calling party. (See. Col. 5, Lines 2-6). Thus, even if one were to combine the teachings of Koralewski with the teachings of Greco et al. the resulting system would not include an information signal or a device for generating an information signal

relating a stored message to at least one graphical image as do the claims of the present invention. Instead the system would include standard signals which were received then associated with graphical images determined by the called party.

Since the combination of these references does not render the independent claims obvious, applicants respectfully request that these rejections be withdrawn and the claims allowed to issue.

The remaining claims are all dependent claims and as such are novel for at least the same reasons discussed above. Accordingly, applicants respectfully request that these rejections be withdrawn as well and the dependent claims also be allowed to issue.

No new matter has been added.

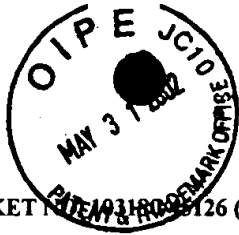
This response attends to each point noted by the Examiner. The claims are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to Applicant's undersigned attorney, to expedite further processing of the application to allowance.

Respectfully submitted,

Dated: May 28, 2002



Richard M. Lehrer, Reg. No. 38,536
GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE
750 Lexington Avenue - 21st Floor
New York, NY 10022
Tel: (212) 486-4000
Fax: (212) 486-4007



ATTORNEY DOCKET NUMBER 103180-45126 (ST0154)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Brian Cruickshank

SERIAL NO: 09/220,962

FILED: December 28, 1998

FOR: Graphical Message Notification

Box NO FEE AMENDMENT
Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED

JUN 05 2002

Technology Center 2600

MARKED UP VERSION OF THE CLAIMS

15. (Amended) A method according to claim [12]13, wherein the receiving step includes receiving the at least one graphical image from the network device.